

2



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,553	05/15/2000	ANDREAS KYNAST	10191/1378	2755
26646	7590	10/20/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			TORRES, MARCOS L	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/554,553

Applicant(s)

KYNAST ET AL.

Examiner

Marcos L. Torres

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6-13-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed June 13, 2005 with respect to claims 8-14 and 16 have been fully considered but they are not persuasive.
2. Regarding applicant's arguments to claims 8-16 that Markovitz does not have a interface located in the infrastructure for adapting data to the terminal, that limitation is taught by Levac (see fig. 1, 5).
3. Regarding applicant's arguments that Levac only refer to different message formats, not to data processing capabilities of the receiving devices, as acknowledge by the applicant Levac discloses adapting data from a plurality of data services to the specific format of the device so the device can process the message ,therefore is adapting to the data processing capability of the device. The current rejection in record stands.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 2687

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (U.S. Patent US005949492A) in view of Levac (U.S. Patent US005872926A).

As to claims 11, 16 and 18, Mankovitz discloses a terminal device for a reception of data from an infrastructure, the terminal device having specific data processing capabilities for processing the data (see col. 7, lines 35-46), the infrastructure making a data service available in a format, the infrastructure including interfaces via which the data in the format is adapted to the data processing capabilities of the terminal device (see col. 11, lines 1-12; col. 9, lines 36-46), the terminal device comprising: means for transmitting a request signal to the infrastructure via which data is requested from the infrastructure and with which information concerning the data processing capabilities is transmitted via the terminal device to the infrastructure (see col. 8, lines 25-31).

Mankovitz do not specifically discloses adapting data to users that have different data processing capabilities. In an analogous art, Levac discloses adapting data to users that have different data processing capabilities (see col. 1, line 61 - col. 2, line 2), thereby reaching various type of user equipment. Since, it is desirable to reach as many users as possible. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Levac teaching to the Mankovitz terminal for the simple reason of compatibility and increased revenue with new users.

As to claim 13, Mankovitz discloses everything claimed as explained above in addition the terminal device, wherein the terminal device is a car radio with supplementary functions (see col. 45, lines 3-10).

As to claim 14, Mankovitz discloses everything claimed as explained above in addition the terminal device, wherein the information concerning the data processing capabilities of the terminal device includes a terminal device identifier (see col. 3, lines 4-30).

As to claim 12, Mankovitz discloses everything claimed as explained above in addition the terminal device, further comprising means for exchanging data with the infrastructure via a telephone network (see col. 9, lines 57-61). Mankovitz do not specifically disclose that the telephone network is a digital mobile network. However, OFFICIAL NOTICE IS TAKEN that the use of digital transmission in telephone network is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use the Makovitz and Levac teachings for the simple reason of using the bandwidth more efficiently.

Regarding claims 8-10 and 17, they are the corresponding method claims of apparatus claims 11-12 and 18. Therefore, claims 8-10 and 17 are rejected for the same reason shown above.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Levac and Ellis (U.S. Patent 5,699,255).

As to claim 15, Mankovitz discloses a method for transmitting information between an infrastructure and data users, the infrastructure including a service provider, the data users including terminal devices in a motor vehicle, the data users having specific data processing capabilities, the method comprising the steps of: making a data service available in a standardized format, using the infrastructure; and via interfaces situated in the infrastructure (see col. 7, lines 35-46; col. 8, lines 25-31; col. 11, lines 1-12; col. 9, lines 36-46).

Mankovitz does not specifically disclose adapting data to the data processing capabilities of the data users or wherein the data includes geographic information. In an analogous art, Levac discloses adapting data to the data processing capabilities of the data users (see col. 1, line 61 - col. 2, line 2), thereby enhancing compatibility and user satisfaction. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Levac teachings to the Makovitz method for the simple purpose of reaching as many users as possible.

Mankovitz and Levac do not specifically disclose wherein the data includes geographic information. In an analogous art, Ellis discloses wherein the data includes geographic information (see col. 2, lines 5-25), thereby allowing sending geographic

Art Unit: 2687

data to user and provide user location services. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these teachings in order to add new subscribers and services, thereby increasing the profits.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any response to this Office Action should be mailed to:

U.S. Patent and Trademark Office  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Art Unit: 2687

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G Kincaid can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres  
Examiner  
Art Unit 2687

  
MLT

  
10/17/05  
LESTER G. KINCAID  
DEPUTY PRIMARY EXAMINER